REMARKS

This is a full and timely response to the non-final Office Action mailed October 28, 2008. Upon entry of the foregoing amendments, claims 1, 3, 4 and 6-26 remain pending in the application. Claims 1, 21, 22 and 25 have been amended. Claims 2 and 5 have been cancelled. The subject matter of amended claims 1, 21, 22 and 25 is supported in Applicant's originally filed specification. Accordingly, no new matter is added to the present application. Applicants request reconsideration of the application and pending claims in light of the foregoing amendments and following remarks.

Claim Rejections Under 35 USC § 103 – Claims 1, 3, 4, and 6-26

    A.   **Statement of the Rejection**

Claims 1, 3, 4, and 6-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Number 6,400,845 to Volino (*Volino*) in view of U.S. Patent Number 6,473,500 to Risafi (*Risafi*).

    B.   **Discussion of the Rejection**

For a claim to be properly rejected under 35 U.S.C. § 103, the Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, the difference or differences in the claim over the applied reference(s), the proposed modification necessary to arrive at the claimed subject matter and an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. It is well settled law that a *prima facie* case of obviousness must teach or suggest all the claimed limitations.

Regarding the requirement to teach or suggest all the claim limitations, MPEP § 2143.03 states "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §

103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants respectfully submit that independent claims 1, 21, 22 and 25, as amended, and independent claim 15, as previously presented, are patentable for at least the reason that the proposed combination of *Volino* and *Risafi* fails to disclose, teach, or suggest each element in the amended claims.

1. Claims 1, 3, 4 and 6-14

Regarding Applicants' claim 1, without conceding the propriety of the asserted combination or whether one of ordinary skill would have been motivated to make the asserted combination for the alleged reasons, Applicants submit that claim 1, as amended, includes at least one feature that is not disclosed, taught or suggested by the proposed combination of *Volino* and *Risafi*. Specifically, Applicants' claim 1, as amended, is directed to a merchant terminal that includes at least "a scanner coupled to the merchant terminal for scanning a personal identification document corresponding to a customer requesting a point-of-sale transaction," and "an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial services transaction via the merchant terminal." Both *Volino* and *Risafi* are silent regarding "a scanner coupled to the merchant terminal for scanning a personal identification document corresponding to a customer requesting a point-of-sale transaction," and "an interface configured to communicate customer data interpreted from the personal identification document."

Applicants respectfully traverse the conclusion that *Volino* discloses a method comprising the step of scanning a personal identification document corresponding to a customer requesting a financial service at a merchant terminal. *Volino* does not disclose, teach or suggest the step of scanning a personal identification document corresponding to a customer requesting a financial service at a merchant terminal. *Volino* is entirely silent concerning a personal identification document corresponding to a customer requesting a financial service at a merchant terminal.

Volino describes systems and methods for extracting textual information from a digital image. Fig. 1 shows a scanner 144 coupled to a data extraction system 100. The data extraction system 100 comprises an image comparator 101, a template mapper 106, a zone optical character reader 110, a zone pattern comparator and data extractor 114, an extracted data parser 118 and a datastore 124. Fig. 2 shows a scanner 144 coupled to a system for creating a master document image 200. The system for creating a master document image 200 includes an image enhancer 220, a zone mapper 226, a zone OCR 232 and a pattern mapper 238. The disclosed elements and features are directed to a process of extracting data from a digital image. Absent from *Volino* is any teaching whatsoever of a merchant terminal for scanning a personal identification document corresponding to a customer requesting a point-of-sale transaction. *Volino* does not teach a merchant terminal. *Volino* does not teach a personal identification document presented by a customer requesting a point-of-sale transaction.

Furthermore, as admitted in the Office Action, *Volino* does not show an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, first paragraph.)

In an effort to remedy the failure of *Volino* to describe, teach or suggest the claimed merchant terminal, *Risafi* is introduced for the alleged disclosure of an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, second paragraph.) Applicants respectfully traverse the conclusion that *Risafi* discloses an interface configured to communicate customer data interpreted from the personal identification document.

Risafi describes a system and method for using a pre-paid card. There are two ways to activate the card – individual activation or batch activation. Individual activation includes a single user purchasing a card from an agent or receiving a card from a program sponsor. The card purchaser selects a PIN (personal identification number). The card issuer or agent transmits the card number, the PIN and the amount to be associated with

the card. (See *Risafi*, column 8, lines 53-63.) In batch activation, of which payroll fulfillment is an example, the issuer or card program sponsor transmits to the processing center, via an issuing bank, a file including the card number, a system assigned PIN, and an initial value to be loaded. (See *Risafi*, column 9, lines 8-14.) A card number, a PIN, and an amount are the only data items communicated to the processing center. Customer data interpreted from a personal identification document is <u>not</u> communicated to the processing center.

As *Volino* and *Risafi* do not collectively disclose, teach or suggest all features recited in claim 1, Applicants respectfully submit that the proposed combination of *Volino* and *Risafi* fails to establish a *prima facie* case of obviousness with respect to claim 1, as amended. Consequently, favorable reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 103 are respectfully requested.

Furthermore, the proposed combination fails to establish a *prima facie* case of obviousness with respect to dependent claims 3, 4 and 6-14, which depend either directly or indirectly from independent claim 1 and include all the features of independent claim 1. *See In re Fine*, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Thus, favorable reconsideration and withdrawal of the rejection of dependent claims 3, 4, and 6-14 under 35 U.S.C. § 103 are respectfully requested.

2. Claims 15-20

Concerning Applicants' claim 15, without conceding the propriety of the asserted combination or whether one of ordinary skill would have been motivated to make the asserted combination for the alleged reasons, Applicants submit that claim 15 includes at least one step that is not disclosed, taught or suggested by the proposed combination of *Volino* and *Risafi*. Specifically, the proposed combination of *Volino* and *Risafi* fails to disclose, teach, or suggest Applicants' claimed method of processing a point-of-sale transaction at a merchant terminal, which includes at least the steps of "scanning a personal identification document corresponding to a customer requesting a financial service at a merchant terminal," and "communicating customer data interpreted from the personal

identification document to a host processing element that supports a financial services transaction via the merchant terminal."

Volino describes systems and methods for extracting textual information from a digital image. As shown above, the disclosed elements and features do not include a merchant terminal for scanning a personal identification document corresponding to a customer requesting a point-of-sale transaction. Furthermore, as admitted in the Office Action, *Volino* does not show an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, first paragraph.)

In an effort to remedy the failure of *Volino* to describe, teach or suggest the claimed method, *Risafi* is introduced for the alleged disclosure of an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, second paragraph.) Applicants respectfully traverse the conclusion that *Risafi* discloses an interface configured to communicate customer data interpreted from the personal identification document.

Risafi describes a system and method for using a pre-paid card. As shown above, a card number, a PIN, and an amount are the only data items communicated to the processing center. Customer data interpreted from a personal identification document is not communicated to the processing center.

Thus, Applicants respectfully submit that the proposed combination of *Volino* and *Risafi* fails to establish a *prima facie* case of obviousness with respect to claim 15 as *Volino* and *Risafi* do not collectively disclose, teach or suggest at least the steps of "scanning a personal identification document corresponding to a customer requesting a financial service at a merchant terminal," and "communicating customer data interpreted from the personal identification document to a host processing element that supports a financial services transaction via the merchant terminal." Consequently, favorable

reconsideration and withdrawal of the rejection of independent claim 15 under 35 U.S.C. § 103 are respectfully requested.

Furthermore, the proposed combination fails to establish a *prima facie* case of obviousness with respect to dependent claims 16-20, which depend either directly or indirectly from independent claim 15 and include all the features of independent claim 15. *See In re Fine, supra.* Thus, favorable reconsideration and withdrawal of the rejection of dependent claims 16-20 under 35 U.S.C. § 103 are respectfully requested.

3. Claim 21

Regarding Applicants' claim 21, without conceding the propriety of the asserted combination or whether one of ordinary skill would have been motivated to make the asserted combination for the alleged reasons, Applicants submit that claim 21 includes at least one step that is not disclosed, taught or suggested by the proposed combination of *Volino* and *Risafi*. Specifically, the proposed combination of *Volino* and *Risafi* fails to disclose, teach, or suggest Applicants' claimed method implemented by a merchant terminal comprising at least the steps of "scanning a personal identification document corresponding to a customer at the merchant terminal," and "communicating customer data interpreted from the personal identification document to support a financial services transaction via the merchant terminal."

Volino describes systems and methods for extracting textual information from a digital image. As shown above, the disclosed elements and features do not include a merchant terminal for scanning a personal identification document corresponding to a customer requesting a point-of-sale transaction. Furthermore, as admitted in the Office Action, *Volino* does not show an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, first paragraph.)

In an effort to remedy the failure of *Volino* to describe, teach or suggest the claimed method, *Risafi* is introduced for the alleged disclosure of an interface configured

to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, second paragraph.) Applicants respectfully traverse the conclusion that *Risafi* discloses an interface configured to communicate customer data interpreted from the personal identification document.

Risafi describes a system and method for using a pre-paid card. As shown above, a card number, a PIN, and an amount are the only data items communicated to the processing center. Customer data interpreted from a personal identification document is not communicated to the processing center.

Thus, Applicants respectfully submit that the proposed combination of *Volino* and *Risafi* fails to establish a *prima facie* case of obviousness with respect to claim 21 as *Volino* and *Risafi* do not collectively disclose, teach or suggest at least the steps of "scanning a personal identification document corresponding to a customer at the merchant terminal," and "communicating customer data interpreted from the personal identification document to support a financial services transaction via the merchant terminal." Consequently, favorable reconsideration and withdrawal of the rejection of independent claim 21 under 35 U.S.C. § 103 are respectfully requested.

4. Claims 22-24

Concerning Applicants' claim 22, without conceding the propriety of the asserted combination or whether one of ordinary skill would have been motivated to make the asserted combination for the alleged reasons, Applicants submit that claim 22 includes at least one feature that is not disclosed, taught or suggested by the proposed combination of *Volino* and *Risafi*. Specifically, the proposed combination of *Volino* and *Risafi* fails to disclose, teach, or suggest Applicants' claimed financial services system, which includes at least "a scanner configured to generate a digital image of a customer's personal identification document at a merchant terminal," and "an interface configured to communicate customer data interpreted from the personal identification document to a

host processing element that supports a financial services transaction via the merchant terminal."

Volino describes systems and methods for extracting textual information from a digital image. As shown above, the disclosed elements and features do not include a merchant terminal. Furthermore, as admitted in the Office Action, *Volino* does not show an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, first paragraph.)

In an effort to remedy the failure of *Volino* to describe, teach or suggest the claimed financial systems, *Risafi* is introduced for the alleged disclosure of an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, second paragraph.) Applicants respectfully traverse the conclusion that *Risafi* discloses an interface configured to communicate customer data interpreted from the personal identification document.

Risafi describes a system and method for using a pre-paid card. As shown above, a card number, a PIN, and an amount are the only data items communicated to the processing center. Customer data interpreted from a personal identification document is not communicated to the processing center.

Thus, Applicants respectfully submit that the proposed combination of *Volino* and *Risafi* fails to establish a *prima facie* case of obviousness with respect to claim 22 as *Volino* and *Risafi* do not collectively disclose, teach or suggest at least the features of "a scanner configured to generate a digital image of a customer's personal identification document at a merchant terminal," and "an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial services transaction via the merchant terminal." Consequently, favorable reconsideration and withdrawal of the rejection of independent claim 22 under 35 U.S.C. § 103 are respectfully requested.

Furthermore, the proposed combination fails to establish a *prima facie* case of obviousness with respect to dependent claims 23 and 24, which depend either directly or indirectly from independent claim 22 and include all the features of independent claim 22. *See In re Fine, supra.* Thus, favorable reconsideration and withdrawal of the rejection of dependent claims 23 and 24 under 35 U.S.C. § 103 are respectfully requested.

5. Claims 25-26

Regarding Applicants' claim 25, without conceding the propriety of the asserted combination or whether one of ordinary skill would have been motivated to make the asserted combination for the alleged reasons, Applicants submit that claim 25 includes at least one feature that is not disclosed, taught or suggested by the proposed combination of *Volino* and *Risafi*. Specifically, the proposed combination of *Volino* and *Risafi* fails to disclose, teach, or suggest Applicants' claimed point-of-sale merchant terminal, which includes at least "a scanner coupled to a point-of-sale merchant terminal, the scanner operable to scan a customer's personal identification document," and "an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial services transaction via the merchant terminal."

Volino describes systems and methods for extracting textual information from a digital image. As shown above, the disclosed elements and features do not include a merchant terminal. Furthermore, as admitted in the Office Action, *Volino* does not show an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a merchant terminal. (See Office Action, page 3, first paragraph.)

In an effort to remedy the failure of *Volino* to describe, teach or suggest the claimed financial systems, *Risafi* is introduced for the alleged disclosure of an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial service transaction via a

merchant terminal. (See Office Action, page 3, second paragraph.) Applicants respectfully traverse the conclusion that *Risafi* discloses an interface configured to communicate customer data interpreted from the personal identification document.

Risafi describes a system and method for using a pre-paid card. As shown above, a card number, a PIN, and an amount are the only data items communicated to the processing center. Customer data interpreted from a personal identification document is not communicated to the processing center.

Thus, Applicants respectfully submit that the proposed combination of *Volino* and *Risafi* fails to establish a *prima facie* case of obviousness with respect to claim 25 as *Volino* and *Risafi* do not collectively disclose, teach or suggest at least the features of "a scanner coupled to a point-of-sale merchant terminal, the scanner operable to scan a customer's personal identification document," and "an interface configured to communicate customer data interpreted from the personal identification document to a host processing element that supports a financial services transaction via the merchant terminal." Consequently, favorable reconsideration and withdrawal of the rejection of independent claim 25 under 35 U.S.C. § 103 are respectfully requested.

Furthermore, the proposed combination fails to establish a *prima facie* case of obviousness with respect to dependent claim 26, which depends directly from independent claim 25 and includes all the features of independent claim 25. *See In re Fine, supra.* Thus, favorable reconsideration and withdrawal of the rejection of dependent claim 26 under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that pending claims 1, 3, 4, and 6-26 are allowable over the cited art of record and the present application is in condition for allowance. Accordingly, a Notice of Allowance is respectfully solicited. Should the Examiner have any comments regarding the Applicant's response, Applicants request that the Examiner telephone Applicant's undersigned attorney.

Respectfully submitted,

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